

REMARKS

By this amendment, claims 1-37 are pending, in which no claims are canceled, currently amended, or newly presented. No new matter is introduced.

The Office Action mailed March 24, 2005 objected to claims 1-37 as obvious under 35 U.S.C. § 103 based on *Ganesan et al.* (US Patent Publication No. 2004/0249766 A1).

Applicant respectfully traverses the rejection of claims 1-37 because *Ganesan et al.* does not teach or make obvious the claimed features.

Independent claims 1 and 29 recite “determining whether the invoice amount is at **least one of a zero balance and a credit balance**; and selectively terminating the payment and **generating a disallow payment message** based upon the determining step.” Claims 8, 15 and 29 include the features of “determining whether the invoice amount is **at least one of a zero balance and a credit balance**, and selectively terminating the payment and **generating a disallow payment message** based upon the determination.” Claim 22 recites “means for determining whether the invoice amount is **at least one of a zero balance and a credit balance**; and means for selectively terminating the payment and **generating a disallow payment message** based upon the determination.” Lastly claim 36 recites “a mechanism for determining whether the total invoice amount is a **zero balance or credit balance** prior to executing the electronic payment, wherein in response to determination of the zero or credit balance, the mechanism terminating the payment mechanism and **generating a disallow payment message** for display to the customer.”

Given the Examiner’s explanation of the terms “zero balance” or “credit balance” (page 2 of the Office Action), it is believed that the Examiner misunderstands these terms, and thus, the operation of the claimed invention. Specifically, the Office Action states “he [Gan] does teach

whether or not the customer has funds sufficient to pay the balance due (credit balance) on the invoice.” First, a “balance due” is contrary in definition to what a “credit balance” means – i.e., a “credit” indicates that no balance is due. Secondly, the *Ganesan et al.* system operates differently from the claimed invention, in that the *Ganesan et al.* system ensures that the purchaser (120a-110n) has sufficient funds to pay the seller (110a-110n) for its product (see FIGs. 1 and 8 and accompanying text). Under the Examiner’s interpretation, the seller (110a-110n) would have to offer their product for free or even offer to pay the purchaser (120a-110n) for the product to result in an invoice that has a “zero balance” or “credit balance.” Not surprisingly, the Examiner is unable to find use of the terms “zero balance” or “credit balance” within the four corners of *Ganesan et al.*, as the *Ganesan et al.* system does not attempt to address the accounting problem of “the downstream accounting problems resulting from an overpayment by employing a Disallow Payment mechanism which prevents the acceptance of customer EFT payments from those customers having a credit or zero balance.” (Specification, page 2). It is well settled that the problem addressed and solved by a claimed invention must be given consideration in resolving the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ 1333 (Fed. Cir. 1993); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ 1321 (Fed. Cir. 1990); *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984).

Further, *Ganesan et al.*, in fact, teaches away the claimed invention, in that the claimed invention provides a mechanism to “disallow payment,” while the *Ganesan et al.* encourages payments. The Examiner misunderstands the use of the “disallow payment message,” and thus, seeks to read this into the *Ganesan et al.* reference. Instead, *Ganesan et al.* teaches the need for

more payments, not less or no payment by checking for sufficiency of funds of the purchaser to satisfy the invoice of the seller. Therefore, it cannot be contemplated by *Ganesan et al.* for a disallow payment mechanism. Cited paragraph [0084] of *Ganesan et al.* states as follows (emphasizes added):

The processor 1100" then generates a signal, which is transmitted via the modem 1160" and port 1165" to the purchaser computer, **either** notifying the purchaser that, the **deposited funds are insufficient**, as indicated in step 880, or **transmitting a purchaser authorization request**, for example in the form of FIG. 6, to the purchaser PC as indicated in step 885. The purchasers response is received by the processor 1100" via the port 1165" and modem 1160". The processor 1100" determines, in step 890, whether the purchaser has authorized the payment of the total purchase price from the deposited funds.

From the above passage, there is no support for use of a "disallow payment message." The purchaser is merely notified that he has insufficient funds, not that he is not allow to make a payment. Therefore, no prima facie case of obviousness has been established.

To the extent that the Office Action is taking Official Notice, pursuant to the MPEP §2144.03, Applicant respectfully traverses the Official Notice and request the Examiner to produce references showing the claim features or withdraw the rejection as factually inadequate.

For the foregoing reasons, Applicant respectfully requests withdrawal of the obviousness rejection over the single reference of *Ganesan et al.*, and urges the indication that independent claims 1, 8, 15, 22, 29 and 36 are allowable.

The rejection of dependent claims 2-7, 9-14, 16-21, 23-28, 30-35, and 37 should likewise be withdrawn for at least the same reasons for the allowability of their corresponding independent claims. These claims are also patentable on their own merits. For example, claim 4 recites "performing a splitter process to parse the invoice information for account number information and invoice amount associated with the customer, wherein a working file is

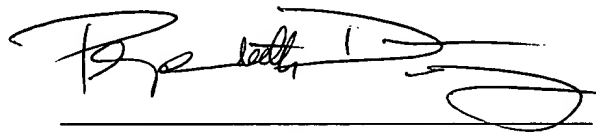
selectively generated based upon comparison of the invoice information with data that is stored in a data store containing enrollment information; and performing an extract process to parse the generated working file based upon a pre-defined extract definition.” *Ganesan et al.* is silent with respect to these features.

Therefore, the present application, as amended, overcomes the rejection of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

DITTHAVONG & CARLSON, P.C.

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Date



Phouphanomketh Ditthavong
Attorney/Agent for Applicant(s)
Reg. No. 44658

10507 Braddock Road
Suite A
Fairfax, VA 22032
Tel. (703) 425-8508
Fax. (703) 425-8518